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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,937	12/03/2003	Takao Sawabe	054791-5019	4488
55694 7590 07/23/2007 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			EXAMINER ZHAO, DAQUAN	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 07/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,937

Applicant(s)

SAWABE ET AL.

Examiner

Daquan Zhao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/30/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 3, 5-8, 9, 13, 15, 17 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3, 9, 15,16,17, 18, 19, 20 and 21 of copending Application No. 10/752,215(it is referred to as #215 from now on). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Regarding claim 1 of the instant application, claims 1,3, 9, 15,16, 17, 18, 19, 20 and 21 of #215 teach an information recording medium on which there are recorded: one or a plurality of first entity information, which is compressed and encoded by a first compressing and encoding method, for individually constituting Titles, each of which is a

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logical combination of contents including at least video; first management information for managing and controlling said first entity information; one or a plurality of second entity information, which is compressed and encoded by a second compressing and encoding method, which is different from the first compressing and encoding method, for individually constituting Titles, each of which is a logical combination of contents same as or different from the contents of said first entity information; and second management information for managing and controlling said first and second entity information.

Regarding claims 5-8 of the instant application, claim 1 of #215 teach menu information, which includes at least video information compressed and encoded by the first or second compressing and encoding method, for indicating a menu for user selection about at least said second entity information out of said first and second entity information; and attribute information for indicating the first or second compressing and encoding method by which said first menu information is compressed and encoded.

Regarding claims 13, 17 and 19 of the instant application, claim 15 of #215 teach An information reproducing apparatus for reproducing an information recording medium, on which there are recorded: one or a plurality of first entity information, which is compressed and encoded by a first compressing and encoding method, for individually constituting Titles, each of which is a logical combination of contents including at least video; first management information for managing and controlling said first entity information; one or a plurality of second entity information, which is compressed and encoded by a second compressing and encoding method, which is

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different from the first compressing and encoding method, for individually constituting Titles, each of which is a logical combination of contents same as or different from the contents of said first entity information; and second management information for managing and controlling said first and second entity information, said apparatus comprising: a reading device for reading out information from the information recording medium; a judgment device for judging whether or not the second management information is recorded on the information recording medium on the basis of the read information; and a reproduction output device (i) for reproducing and outputting the first or second entity information in accordance with the second management information if it is judged by said judgment device that the second management information is recorded and (ii) for reproducing and outputting the first entity information in accordance with first management information if it is judged by said judgment device that the second management information is not recorded.

Claim 17 of #215 encompasses all the limitation of **claim 15** of the instant application

Regarding claim 3 of the instant application, claims 3 of #215 teach attribute information for indicating the compressing and encoding method for each of said first entity information; and attribute information for indicating the compressing and encoding method for each of said second entity information.

Regarding claim 9 of the instant application, claim 3 of #215 teach second management information manages and controls said first entity information, by

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specifying said first management information, through said specified first management information.

2. Claims 2, 4, 14, 16, 18 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over 1,3, 9, 15,16,17, 18, 19, 20 and 21 of copending Application No. 10/752,215(it is referred to as #215 from now on) as applied to claims 1, 3, 5-8, 9, 13, 15, 17 and 19 of the instant application above and further in view of Ito et al (US 6,598,101 B1).

Regarding claims 2, 4, 14, 18 and 20 of the instant application, #215 fail to teach number information for indicating an identification number of said first or second entity information, which is uniquely given to each Title; and identification information for identifying whether said number information indicates the identification number of said first entity information or the identification number of said second entity information. Ito et al teach number information for indicating an identification number of said first or second entity information, which is uniquely given to each Title; and identification information for identifying whether said number information indicates the identification number of said first entity information or the identification number of said second entity information (e.g. figure 2, column 4, lines 23-35). It would have been obvious for one ordinary skill in the art at the time the invention was made to incorporate the teaching of Ito et al into the teaching of #215 for storage efficiency since Ito et al suggest in column 2, lines 23-28 to position the data in the recording medium for continuous recording.

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Claim 17 of #215 encompasses all the limitation of **claim 16** of the instant application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-12 are rejected under 35 U.S.C. 101 because independent Claims 1 and 10 are directed to a recording medium containing video data, wherein the video data is consider to be nonfunctional descriptive material.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re *Sarkar*, 588 F.2d1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must

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be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claims 2-9 and 11-12 are also affected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Komoda et al (US 6,701,063 B1).

Regarding claim 1, Komoda et al teach an information recording medium on which there are recorded: one or a plurality of first entity information, which is compressed and encoded by a first compressing and encoding method, for individually

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constituting Titles (e.g. column 1, lines 44-51, video data recorded under a video standard, wherein the video standard is the MPEG standard taught in column 4, lines 45-58), each of which is a logical combination of contents including at least video; first management information for managing and controlling said first entity information (e.g. column 2, line 58- column 3, line 17, the directory of figure 2, which includes 201, 202 and 203 corresponds to the management information); one or a plurality of second entity information, which is compressed and encoded by a second compressing and encoding method, which is different from the first compressing and encoding method, for individually constituting Titles, each of which is a logical combination of contents same as or different from the contents of said first entity information (e.g. column 1, lines 44-51, video data encoded by a different method is recorded on the optical disc, where the "different method" is taught in column 4, line 46-59 to be JPEG, which is used to compressed high resolution video data); and second management information for managing and controlling said first and second entity information (e.g. column 2, line 58- column 3, line 17, the directory of figure 2, which includes 201, 202 and 203 corresponds to the management information).

Regarding claim 9, Komoda et al teach second management information manages and controls said first entity information, by specifying said first management information, through said specified first management information (e.g. column 2, line 58- column 3, line 17, the directory of figure 2, which includes 201, 202 and 203 corresponds to the management information. Claim does not require the first and second management information to be different).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komoda et al (6,701,063 B1) as applied to claims 1 and 9 above, and further in view of Ito et al (US 6,598,101 B1).

See the teaching of Komoda et al above.

Regarding claim 2, Komoda et al fail to specify number information for indicating an identification number of said first or second entity information, which is uniquely given to each Title; and identification information for identifying whether said number information indicates the identification number of said first entity information or the identification number of said second entity information. Ito et al teach number information for indicating an identification number of said first or second entity information, which is uniquely given to each Title; and identification information for identifying whether said number information indicates the identification number of said first entity information or the identification number of said second entity information (e.g. figure 2, column 4, lines 23-35). It would have been obvious for one ordinary skill in the art at the time the invention was made to incorporate the teaching of Ito et al into the teaching of Komoda et al for storage efficiency since Ito et al suggest in column 2, lines 23-28 to position the data in the recording medium for continuous recording.

Regarding claim 4, Ito et al teach second management information includes: total number information for indicating the total number of said first entity information; and total number information for indicating the total number of said second entity information (e.g. figure 2, column 4, lines 23-35).

6. Claims 3, 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komoda et al (US 6,707,063 B1) as applied to claims 1 and 9 above, and further in view of Inoue et al (US 2001/0,006,579 A1).

See the teaching of Komoda et al above.

Regarding claim 3, Komoda et al fail to teach the compressing and encoding method for the first entity and second entity information. Inoue et al teach the compressing and encoding method for the first entity and second entity information (e.g. paragraph [111]). It would have been obvious for one ordinary skill in the art at the time the invention was made to incorporate the teaching of Inoue et al into the teaching of Komoda et al to enhance the operating speed of the system (Inoue et al, paragraph [0004]).

Regarding claims 5-8, Inoue et al teach menu information, which includes at least video information compressed and encoded by the first or second compressing and encoding method, for indicating a menu for user selection about at least said second entity information out of said first and second entity information (e.g. figure 3 and [0030] teach the switch for user to record moving picture or still image); and attribute information for indicating the first or second compressing and encoding method

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by which said first menu information is compressed and encoded (e.g. figure 6, [0054]-[0055] teach a menu, wherein column 602 in figure 6 indicates the MPEG encoding method and column 603 in figure 6 indicates the JPEG encoding method. Rows 605, 606, 607 and 608 in figure 6 are considered to be the first, second, third and fourth menu information, respectively).

7. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (US 6,598,101 B1) and further in view of Inoue et al (2001/0,006,579 A1).

Regarding claim 10, Ito et al teach an information recording medium on which there are recorded: one or a plurality of entity information, which is compressed and encoded by a predetermined compressing and encoding method, for individually constituting Titles, each of which is a logical combination of contents including at least video; and management information for managing and controlling said entity information, said management information including: number information for indicating an identification number of said entity information, which is uniquely given to each Title; total number information for indicating the total number of said entity information (e.g. figure 2, column 4, lines 23-35); However, Ito et al fail to teach information for indicating a fact that there is no record of another entity information compressed and encoded by another compressing and encoding method, which is different from the predetermined compressing and encoding method. Inoue et al teach information for indicating a fact that there is no record of another entity information compressed and encoded by another compressing and encoding method, which is different from the predetermined

compressing and encoding method (e.g. [0120], [0054] and figure 6, Inoue et al teach a menu in figure 6 to indicate the number of still picture files recorded, 603, and the number of moving picture files recorded, wherein the still picture is compressed using JPEG and the moving picture is compressed using MPEG. The number of these file recorded depends on the user. Therefore, if the user did not record any still image, the number for "603" would be 0, which would indicate "no record of another entity information compressed and encoded by another compressing and encoding method"). It would have been obvious for one ordinary skill in the art at the time the invention was made to incorporate the teaching of Inoue et al into the teaching of Ito et al to enhance the operating speed of the system (Inoue et al, paragraph [0004]).

Regarding claims 11 and 12, Inoue et al teach menu information, which includes at least video information compressed and encoded by the first or second compressing and encoding method, for indicating a menu for user selection about at least said second entity information out of said first and second entity information (e.g. figure 3 and [0030] teach the switch for user to record moving picture or still image); and attribute information for indicating the first or second compressing and encoding method by which said first menu information is compressed and encoded (e.g. figure 6, [0054]-[0055] teach a menu, wherein column 602 in figure 6 indicates the MPEG encoding method and column 603 in figure 6 indicates the JPEG encoding method. Rows 605, 606, 607 and 608 in figure 6 are considered to be the first, second, third and fourth menu information, respectively).

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8. Claims 13, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komoda et al (US 6,701,063 B1) as applied to claims 1 and 9 above, and further in view of Yokota (US 5,754,521).

See the teaching of Komoda et al above.

Regarding claims 13, 17 and 19, Komoda et al fail to teach judging the management information is recorded and reproducing the entity information according the management information. Yokota teach judging the management information is recorded and reproducing the entity information according the management information (e.g. column 12, lines 13-23 and lines 42-44). It would have been obvious for one ordinary skill in the art at the time the invention was made to incorporate the teaching of Yokota into the teaching of Komoda et al to effectively reproduce data from the recording medium (Yokota, column 5, lines 21-30).

Regarding claim 15, Komoda et al teach a decoding device which includes a first decoder corresponding to the first compressing and encoding method and a second decoder corresponding to the second compressing and encoding method (e.g. column 2, lines 26-33, data decoder 112 must be able to decode JPEG and MPEG data since data are encoded in these two format).

9. Claims 14, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komoda et al (US 6,701,063 B1) and Ito et al (US 6,598,101 B1) as applied to claims 1, 2, 4 and 9 above, and further in view of Yokota (US 5,754,521).

See the teaching of Komoda et al and Ito et al above.

Regarding claims ~~14~~ 18 and 20 above, Ito et al also teach identifying an identification number of the entity information corresponding to the selected Title (e.g. column 5, lines 15-24). However, Komoda et al and Ito et al fail to teach judging the management information is recorded and reproducing the entity information according the management information. Yokota teach judging the management information is recorded and reproducing the entity information according the management information (e.g. column 12, lines 13-23 and lines 42-44). It would have been obvious for one ordinary skill in the art at the time the invention was made to incorporate the teaching of Yokota into the teaching of Komoda et al and Ito et al to effectively reproduce data from the recording medium (Yokota, column 5, lines 21-30).

Regarding claim 16, Komoda et al teach a decoding device which includes a first decoder corresponding to the first compressing and encoding method and a second decoder corresponding to the second compressing and encoding method (e.g. column 2, lines 26-33, data decoder 112 must be able to decode JPEG and MPEG data since data are encoded in these two format).

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Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sawabe et al (US 6,687,211 B2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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